

**REMARKS****Overview**

Claims 1-19 are pending in this application. Claims 1, 9, and 12 have been amended. The present response is an earnest effort to place all claims in proper form for immediate allowance. Reconsideration and passage to issuance is therefore respectfully requested.

**Issues Under 35 U.S.C. § 101.**

Claims 1-19 have been rejected under 35 U.S.C. § 101 because the Examiner indicates that the claimed invention is directed towards non-statutory subject matter. The Examiner applies a two-prong test without providing any citation to authority for this test. It is noted that the first prong of this test "whether the invention is within a technological arts" is inconsistent and contrary to the U. S. Supreme Court's most recent decision interpreting 35 U.S.C. § 101. The Examiner is directed towards the most recent U. S. Supreme Court authority on patent eligible subject matter, *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred International, Inc.*, 534 U.S. 124, 122 S.Ct. 593 (2001), noting that the language of § 101 is extremely broad. In addition, that same case also recognizes that § 101 is a dynamic provision designed to encompass new and unforeseen inventions. Therefore, the U. S. Supreme Court's most recent articulation of 35 U.S.C. § 101 provides a far broader view of patent eligible subject matter than that which the Examiner articulates and the two-prong tests suggested by the Examiner, without authority, is inconsistent with the governing Supreme Court authority. Therefore, this rejection must be withdrawn on that basis. It is further observed that should the Examiner be attempting to rely upon *Ex Parte Bowman*, 61 U.S.P.Q.2d 1669 (2001), (a non-precedential opinion) which applied a "technological art" rejection based on the Constitution, Article I, Section 8, in *J.E.M. Ag Supply, Inc. V. Pioneer Hi-Bred International, Inc.*, the U. S. Supreme Court specifically refused

to add any additional constitutional requirements into 35 U.S.C. § 101. Therefore, any such reliance is misplaced.

It is further observed, that even applying the Examiner's improper test, that claims 1-19 meet the requirements of 35 U.S.C. § 101. Claim 1 has been amended to require a "computer-assisted" method. It is respectfully submitted that a new use of a computer promotes the progress of science and useful arts. Claims 9 and 12 have been similarly amended. Therefore, it is respectfully submitted that this rejection should be withdrawn for this independent reason as well.

#### **Issues Under 35 U.S.C. § 112**

Claims 1-19 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, with respect to claim 1, the Examiner indicates that the body of the claim fails to recite how the "minimizing the inconvenience" function in the preamble is accomplished. The Examiner also indicates that the "first ever" on line 1 of claim 1 is confusing, not positively recited and not defined by the steps of the claim.

Claim 1 has been amended to remove the language of "first ever". Therefore, it is respectfully submitted that this rejection should be withdrawn. Also, claim 1 has been amended to add the following clause to the body: "to thereby maximize health care savings while minimizing inconvenience to participants in changing health care providers for participants in the virtual health care network." It is therefore respectfully submitted that the Examiner's rejection has been remedied and should be withdrawn.

With respect to claim 9, the Applicant has removed the use of the word "new" in the preamble. The Applicant has also removed the language "while minimizing the inconvenience to

health care participants in changing health care providers." Therefore, it is respectfully submitted that this rejection should also be withdrawn.

With respect to claim 12, the Examiner indicates that the body of the claim fails to recite how the "selecting" function in the preamble is accomplished. Also, the Examiner indicates that "a new method" on line 1 of claim 12 is confusing, not positively recited and not defined by the steps of the claim. Claim 12 has been amended to remove the word "new" and the word "selecting" from the preamble. Therefore, it is respectfully submitted that these rejections must be withdrawn.

As dependent claims 2-8, 10, 13-19 were only rejected on the basis that they incorporated deficiencies of the claims they depend upon, it is respectfully submitted that these rejections have also been remedied.

#### **Issues under 35 U.S.C. § 103**

Claims 1-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 5,706,441 to Lockwood in view of U.S. 2002/0123905 A1 to Goodroe et al and "For Health Benefits, Point and Click" by Leonard Bill. These rejections are respectfully traversed.

None of the references provided by the Examiner are directed towards solving the same problem addressed by the claimed invention. In particular, none of the references are directed towards creating a virtual health care network that maximizes health care savings while minimizing inconvenience to participants in changing health care providers for participants in the virtual health care network, as required by claim 1.

In addition to not considering the problem addressed by the invention of claim 1, the Examiner also misapplies Lockwood. Lockwood provides a method and apparatus for

objectively monitoring and assessing the performance of health-care providers. Lockwood does not disclose "providing one or more health care networks in each of the states for analysis." Rather, Lockwood looks at health-care providers within a group of health-care providers in order to assess the complexity of health-care services delivered by each health-care provider (column 4, lines 35-60). Thus, Lockwood is not concerned with evaluating different health care networks within the same state in order to select the health care network having the highest projected savings. Thus, Lockwood is largely irrelevant to the claimed invention as Lockwood looks to evaluating health care providers within a group of health care providers, as opposed to health care networks. Moreover, Lockwood is directed towards examining particular benchmarks with respect to health care providers, which do not equate to the "measure of network utilization" of claim 1. Therefore, this rejection must be withdrawn as neither Goodroe nor Leonard remedies the deficiencies of Lockwood.

It is further observed, that another reference cited by the Examiner discloses "forming a virtual health care network from . . . one or more health care networks per state having the highest projected savings." Leonard discloses a "virtual PPO", but uses the term "virtual PPO" in a different manner. Thus, it is respectfully submitted that this rejection should be withdrawn for this reason as well.

As claims 2-8 depend from claim 1, these rejections should also be withdrawn.

With respect to claim 9, claim 9 requires "for each of the networks having the highest utilization, calculating future savings for the network based upon historical health care costs for planned participants, network discounts, and a portion of the historical health care costs projected to fall to a health care provider in the network." This limitation is not disclosed by any of the

references cited by the Examiner. Therefore, this rejection must be withdrawn. As claims 10-11 depend from claim 9, these rejections should also be withdrawn.

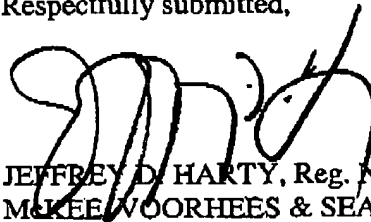
With respect to claim 12, claim 12 requires "projecting future health care savings based upon the average network discount per participant and a number of participants in the network." This limitation is not described in any of the references cited by the Examiner. Therefore, this rejection must be withdrawn. As claims 13-17 depend from claim 12, these rejections should also be withdrawn.

### Conclusion

Therefore, as the Examiner has failed to establish a *prima facie* case of obviousness with respect to each of the claims, these rejections must be withdrawn and the Examiner should find all claims allowable.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Respectfully submitted,



JEFFREY D. HARTY, Reg. No. 40,639  
MCKEE VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
Phone No: (515) 288-3667  
Fax No: (515) 288-1338  
CUSTOMER NO: 22885

Attorneys of Record

- bja -